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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,892	11/26/2003	Mathias Alterman	E072.1010.1	5982

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WOMBLE CARYLE
Post Office Box 7037
Atlanta, GA 30357-0037

EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/721,892

Applicant(s)

ALTERMAN ET AL.

Examiner

Laura L. Stockton, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

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DETAILED ACTION

Claims 1-41 are pending in the application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 4, 6, 9-24, 26, 27 and 32-35, drawn to products of formula I wherein X_1 is N and X_2 is $C(R^1)$ **or** X_1 is $C(R^1)$ and X_2 is N; X_3 is N, and X_4 is N (tetrazole), classified in class 548, subclass 250+.
- II. Claims 1-3, 6, 7, 9-24, 26, 27 and 32-35, drawn to products of formula I wherein X_1 is $C(R^1)$, X_2 is N, X_3 is N and X_4 is $C(R^3)$; **or** X_1 is N, X_2 is $C(R^1)$, X_3 is $C(R^2)$ and X_4 is N (1,2,4-triazole), classified in class 548, subclass 262.2+.
- III. Claims 1, 8-24, 26, 27 and 32-35, drawn to products of formula I wherein X_1 is N and X_2 is

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$C(R^1)$, X_3 is $C(R^2)$ and X_4 is $C(R^3)$ (pyrazole),
classified in class 548, subclass 356.1+.

IV. Claims 1, 5, 9-27 and 32-35, drawn to products
of formula I wherein X_1 is $C(R^1)$, X_2 is N, X_3 is
 $C(R^2)$ and X_4 is $C(R^3)$ (imidazole), classified in
class 548, subclass 311.1+.

V. Claims 1, 9-24, 27 and 32-35, drawn to products
of formula I wherein X_1 is N, X_2 is $C(R^1)$, X_3 is
 $C(R^2)$ and X_4 is $C(R^3)$ (1,2,3-triazole),
classified in class 548, subclass 255+.

VI. Claims 28-31, drawn to methods of using
products of formula I wherein X_1 is N and X_2 is
 $C(R^1)$ **or** X_1 is $C(R^1)$ and X_2 is N; X_3 is N, and X_4
is N (tetrazole), classified in class 514,
subclass 381+.

VII. Claims 28-31, drawn to methods of using
products of formula I wherein X_1 is $C(R^1)$, X_2 is
N, X_3 is N and X_4 is $C(R^3)$; **or** X_1 is N, X_2 is

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$C(R^1)$, X_3 is $C(R^2)$ and X_4 is N (1,2,4-triazole),
classified in class 514, subclass 383+.

VIII. Claims 28-31, drawn to methods of using
products of formula I wherein X_1 is N and X_2 is
 $C(R^1)$, X_3 is $C(R^2)$ and X_4 is $C(R^3)$ (pyrazole),
classified in class 514, subclass 403+.

IX. Claims 28-31, drawn to methods of using
products of formula I wherein X_1 is $C(R^1)$, X_2 is
N, X_3 is $C(R^2)$ and X_4 is $C(R^3)$ (imidazole),
classified in class 514, subclass 385+.

X. Claims 28-31, drawn to methods of using
products of formula I wherein X_1 is N, X_2 is
 $C(R^1)$, X_3 is $C(R^2)$ and X_4 is $C(R^3)$ (1,2,3-
triazole), classified in class 514, subclass
359.

XI. Claims 36, drawn to process of making products
of formula I, classified in class 548, various
subclasses.

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XII. Claim 37, drawn to products of formula II

wherein X_1 is N and X_2 is $C(R^1)$ or X_1 is $C(R^1)$ and X_2 is N; X_3 is N, and X_4 is N (tetrazole), classified in class 548, subclass 250+.

XIII. Claim 37, drawn to products of formula II

wherein X_1 is $C(R^1)$, X_2 is N, X_3 is N and X_4 is $C(R^3)$; or X_1 is N, X_2 is $C(R^1)$, X_3 is $C(R^2)$ and X_4 is N (1,2,4-triazole), classified in class 548, subclass 262.2+.

XIV. Claim 37, drawn to products of formula II

wherein X_1 is N and X_2 is $C(R^1)$, X_3 is $C(R^2)$ and X_4 is $C(R^3)$ (pyrazole), classified in class 548, subclass 356.1+.

XV. Claims 37 and 38, drawn to products of formula

II wherein X_1 is $C(R^1)$, X_2 is N, X_3 is $C(R^2)$ and X_4 is $C(R^3)$ (imidazole), classified in class 548, subclass 311.1+.

XVI. Claim 37, drawn to products of formula II

wherein X_1 is N, X_2 is $C(R^1)$, X_3 is $C(R^2)$ and X_4

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is $C(R^3)$ (1,2,3-triazole), classified in class 548, subclass 255+.

XVII. Claim 39, drawn to products of formula V wherein X_1 is N and X_2 is $C(R^1)$ **or** X_1 is $C(R^1)$ and X_2 is N; X_3 is N, and X_4 is N (tetrazole), classified in class 548, subclass 250+.

XVIII. Claim 39, drawn to products of formula V wherein X_1 is $C(R^1)$, X_2 is N, X_3 is N and X_4 is $C(R^3)$; **or** X_1 is N, X_2 is $C(R^1)$, X_3 is $C(R^2)$ and X_4 is N (1,2,4-triazole), classified in class 548, subclass 262.2+.

XIX. Claim 39, drawn to products of formula V wherein X_1 is N and X_2 is $C(R^1)$, X_3 is $C(R^2)$ and X_4 is $C(R^3)$ (pyrazole), classified in class 548, subclass 356.1+.

XX. Claim 39, drawn to products of formula V wherein X_1 is $C(R^1)$, X_2 is N, X_3 is $C(R^2)$ and X_4 is $C(R^3)$ (imidazole), classified in class 548, subclass 311.1+.

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XXI. Claim 39, drawn to products of formula V

wherein X_1 is N, X_2 is $C(R^1)$, X_3 is $C(R^2)$ and X_4 is $C(R^3)$ (1,2,3-triazole), classified in class 548, subclass 255+.

XXII. Claim 40, drawn to products of formula VII

wherein X_1 is N and X_2 is $C(R^1)$ or X_1 is $C(R^1)$ and X_2 is N; X_3 is N, and X_4 is N (tetrazole), classified in class 548, subclass 250+.

XXIII. Claim 40, drawn to products of formula VII

wherein X_1 is $C(R^1)$, X_2 is N, X_3 is N and X_4 is $C(R^3)$; or X_1 is N, X_2 is $C(R^1)$, X_3 is $C(R^2)$ and X_4 is N (1,2,4-triazole), classified in class 548, subclass 262.2+.

XXIV. Claim 40, drawn to products of formula VII

wherein X_1 is N and X_2 is $C(R^1)$, X_3 is $C(R^2)$ and X_4 is $C(R^3)$ (pyrazole), classified in class 548, subclass 356.1+.

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XXV. Claim 40, drawn to products of formula VII

wherein X_1 is $C(R^1)$, X_2 is N, X_3 is $C(R^2)$ and X_4 is $C(R^3)$ (imidazole), classified in class 548, subclass 311.1+.

XXVI. Claim 40, drawn to products of formula VII

wherein X_1 is N, X_2 is $C(R^1)$, X_3 is $C(R^2)$ and X_4 is $C(R^3)$ (1,2,3-triazole), classified in class 548, subclass 255+.

XXVII. Claim 41, drawn to products of formula IX

wherein X_1 is N and X_2 is $C(R^1)$ **or** X_1 is $C(R^1)$ and X_2 is N; X_3 is N, and X_4 is N (tetrazole), classified in class 548, subclass 250+.

XXVIII. Claim 41, drawn to products of formula IX

wherein X_1 is $C(R^1)$, X_2 is N, X_3 is N and X_4 is $C(R^3)$; **or** X_1 is N, X_2 is $C(R^1)$, X_3 is $C(R^2)$ and X_4 is N (1,2,4-triazole), classified in class 548, subclass 262.2+.

XXIX. Claim 41, drawn to products of formula IX

wherein X_1 is N and X_2 is $C(R^1)$, X_3 is $C(R^2)$ and

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X_4 is $C(R^3)$ (pyrazole), classified in class 548, subclass 356.1+.

XXX. Claims 41, drawn to products of formula IX

wherein X_1 is $C(R^1)$, X_2 is N, X_3 is $C(R^2)$ and X_4 is $C(R^3)$ (imidazole), classified in class 548, subclass 311.1+.

XXXI. Claim 41, drawn to products of formula IX

wherein X_1 is N, X_2 is $C(R^1)$, X_3 is $C(R^2)$ and X_4 is $C(R^3)$ (1,2,3-triazole), classified in class 548, subclass 255+.

The inventions are distinct, each from the other because of the following reasons: the products of Groups I-V and XII-XXXI differ materially in structure and element so much so as to be patentably distinct. In addition, a reference that anticipates one group may not even render obvious the other.

Inventions of Groups I-V and Groups VI-X are related as product and process of use. The inventions

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can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product.

Inventions of Groups I-V and Group XI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make other and materially different products.

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Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for Group I, for example, is not required for Group III, restriction for examination purposes as indicated is proper. Therefore, it would impose an undue burden on the Examiner and the Patent Office's resources to examine the instant application if unrestricted.

The above groups themselves are inclusive of patentably distinct subject matter. Accordingly, along with the election of one of the above groups, the following action is also taken.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (e.g., Example number, page number and structural depiction) from whichever group

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is ultimately elected, even though this requirement is traversed.

Additionally, if a method of use group is elected (i.e., Group VI or Group VII or Group VIII or Group IX or Group X), Applicant is also required to elect a single disclosed method of use. For example, a method of treating asthma. See instant claim 30.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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Upon the election of a single disclosed species (e.g. Example, page number and structural depiction), a scope of the elected invention that has been examined, inclusive of the elected species, will be identified by the Examiner for examination.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable,

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the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

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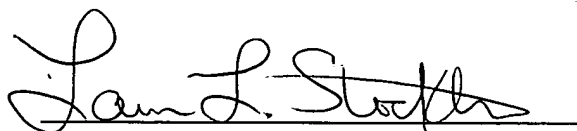
Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

A handwritten signature in black ink, appearing to read "Laura L. Stockton", written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

March 15, 2006